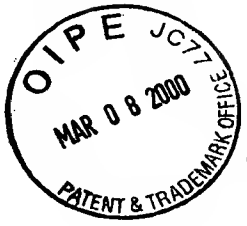
PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re application of

Jean PLOUET et al.

Serial No. 09/091,561 GROUP 1644

Filed August 21, 1998 Examiner G. Ewoldt

ANTI-IDIOTYPIC ANTIBODIES OF VASCULAR ENDOTHELIAL GROWTH FACTOR AND USE THEREOF AS DRUGS

RESPONSE

Assistant Commissioner for Patents

Washington, D.C. 20231

Sir:

Responsive to the restriction requirement imposed in the Official Action of December 8, 1999, applicants hereby provisionally elect Group IV, claims 25-30 and 32-35, with traverse. The grounds for traverse are as follows.

The Official Action fails to set forth any basis that could even ostensibly support a requirement for restriction among the five Groups as formulated in the Official Action. The attempted bases set forth at Items 8-12 of the Official Action will be addressed below in turn, to demonstrate wherein they plainly fail to support a restriction requirement.

At Item 8 of the Official Action, the Examiner contended that Groups I-V to not relate to a single general inventive concept under PCT Rule 13.1, alleging that they lack the same or corresponding special technical feature within the meaning of PCT Rule 13.2.

However, Item 8 discusses solely Group IV, and therefore fails on its face to establish the lack of a common special technical feature as among the five Groups.

Instead, Item 8 of the Official Action takes the bewildering approach of arguing that the claims of Group IV lack a special technical feature relative to two pieces of alleged prior art, which has nothing whatsoever to do with the question of whether the various groups of claims pending in the present application share a common technical feature among themselves.

Moreover, the discussion at Item 8 of the Official Action contends that the claims of Group IV were "found to have no special technical feature that defined the contribution over the prior art of..." each of the two citations discussed. However, it is unclear when such finding was made, and by whom, given that there has been no action on the merits of the present application.

With regard to HIRTH 5,942,385, we observe that this patent is not even prior art to the present application, as its U.S. filing date of March 21, 1996 is subsequent to the French priority date of December 21, 1995 enjoyed by the present application.

On the other hand, the PLOUET et al. Abstract EZ 311 describes an anti-idiotypic antibody whose properties are <u>specifically different</u> from those of the claimed antibody. In particular, the abstract expressly discloses that the antibody is <u>not</u> internalized, but rather induces migration of aortic

endothelial cells. In complete contrast, the antibody of the present invention does not induce migration of endothelial cells (see page 5, line 10), and can be internalized (see Figure 2B). As the antibody of the PLOUET et al. EZ 311 Abstract induces migration, this means that it is a ligand of flt, whereas the antibody of the present invention is a ligand of the human KDR receptor or murine flk-1 receptor, but not a ligand of flt. The anti-idiotypic antibody of the present invention is therefore specific, which is not the case of the anti-idiotypic antibody of the PLOUET et al. abstract. Moreover, from page 10, lines 24 and 25, as well as from Figure 2B of the present application, it is established that the antibody of the present invention is internalized. Consequently, the antibody of the present invention is suited for entirely different therapeutical purposes from those of the PLOUET et al. abstract. Still further, the disclosure of the PLOUET et al. abstract could not even be used to prepare an anti-idiotypic antibody as in the present invention.

Therefore, the discussion appearing at Item 8 of the Official Action is not only wholly irrelevant to any restriction requirement, but also fundamentally mistaken even when viewed as a premature action on the merits of any of the present claims. Consequently, the conclusion stated at Item 9 of the Official Action is baseless.

At Item 10 of the Official Action, Groups I-III are characterized as being different methods, requiring different ingredients, process steps and/or endpoints. That is the

total discussion offered in justification of the ensuing conclusion that the Groups are therefore patentably distinct.

It is incredible that Item 10 of the Official Action would contend that any difference in claim scope renders claims patentably distinct, but that is precisely the contention made in this section of the Official Action. Plainly, a mere difference in claim scope is *per se* insufficient as a matter of law to support a requirement for restriction. However, if the restriction requirement is to be maintained on that basis, then applicants will expect to enjoy the same standard of patentability during examination on the merits of their claimed invention.

At Items 11 and 12 of the Official Action, the Examiner attempts to offer further justification for the improper restriction requirement, with reference to Chapter 800 of the MPEP. That approach is also improper as a matter of law. The present application is the U.S. National Stage of a PCT International application, and the U.S. Patent and Trademark Office has been under standing orders for the past 14 years, from a court of competent jurisdiction, that it is not entitled to apply the MPEP Chapter 800 restriction standards in such a case. *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. Va. 1986). Instead, the PTO is bound by treaty to apply the standards of PCT Rule 13, which, as the above discussion of Item 8 of the Official Action demonstrates, it is unable to do in this case.

Still further, it bears noting that, during the International Phase of the PCT application, no lack of unity was found with respect to a corresponding set of claims 1-17, such that the U.S. Examiner cannot now credibly contend that any undue searching burden would be imposed by examining all of the pending claims 18-35.

Lastly, we note that the Groups as formulated in the outstanding Official Action include an indication of allegedly disparate classification within the U.S. Classification Schedule. However, separate classification is no evidence whatsoever of the propriety of a restriction requirement. The U.S. Classification Schedule is an expedient adopted for the convenience of the Patent Office and the searching public, and cannot in any way be used as a pretext to diminish an applicant's right to a complete examination on the merits of its claimed invention.

From the above discussion, therefore, it is believed to be apparent that the restriction requirement is improper as a matter of law and fatally defective on a number of bases, and therefore must be withdrawn. Full and favorable action on

the merits of all of pending claims 18-35 is accordingly respectfully requested.

Respectfully submitted,

YOUNG & THOMPSON

By _____

Andrew J. Patch
Attorney for Applicants
Registration No. 32,925
745 South 23rd Street
Arlington, VA 22202
Telephone: 703/521-2297

March 8, 2000